

REMARKS

Upon entry of the above amendments, this application will contain claims 1-34 and 37-74 pending and under consideration. The application was originally filed with claims 1-34. In a Preliminary Amendment, claims 35 and 36 were canceled and new claims 40-74 were added. In the present Submission, claims 1, 29, 43, 50, 56, 62, 68, and 74 have been amended; no new claims have been added; and no other claims have been canceled. As discussed more fully below, it is believed that the claims are patentable. Reconsideration leading to allowance of all pending claims is requested.

I. Provisional Obviousness Double Patenting Rejection

Claims 1-34 and 37-74 were provisionally rejected on the ground of judicially created, non-statutory double patenting over claims 1-20 and 23-25 of the copending application, serial no. 10/510,393 (publication no. US2005/0240001, hereinafter “Evers ‘001”). Specific reference was made to the species in claim 25 in Evers ‘001.

Upon indication of allowable subject matter, the undersigned will submit an acceptable terminal disclaimer in this case of the co-pending case, whichever case is allowed last.

Claims 1-34 and 37-74 were rejected on the ground of judicially created, non-statutory double patenting over claims 1-44 of US 7,125,840 (hereinafter “Dodge”). Specific reference was made the species in example 13. The undersigned concurs that the species in example 13 is encompassed within the scope of claim 1 in Dodge. It is understood that the claims of the issued patent and the currently pending application that must be compared to sustain a provisional obviousness double patenting rejection.

In the present application, claim 1 has been further amended, specifically referring the variables for R₅, to recite that “wherein the substituted C₁-C₆ alkyl is substituted with one or more groups selected from: halo, hydroxyl, -OC₁-C₆ alkyl, cyano, SO₂(C₁-C₆ alkyl), OCF₃, CF₃, CONH₂, CON(CH₃)₂, or NO₂”. Support for this amendment can be found in the application as filed at ¶0120. (All citations to the present application refer to the published US patent application no. US 20060167268.)

At least one of the provisos in claim 1, lines 35 through 45 (referring to the amended claim in this Submission), which are written in the alternative, serve to distinguish the presently claimed invention from that in Dodge. The following compares the provisos in claim 1 of the present application to the corresponding variables in the claims of Dodge.

1. In the first proviso, R1 is “(*substituted C₁-C₆alkyl*)NHR10 or (unsubstituted or substituted C₃-C₈ cycloalkyl)NHR10”. (Emphasis added.) The other variables, R2-R11, are not further limited from their initial definitions in the claim.

In Dodge, R1 is “NHR10 or C₁ C₆ alkylNHR10”. The alkyl moiety in alkylNHR10 is not substituted as in the instant claims nor is R1 a (unsubstituted or substituted C₃-C₈ cycloalkyl)NHR10.

2. In the second proviso, R5 is “hydroxy, C₁-C₆alkoxy, or *substituted C₁-C₆alkyl*”, and the substituted C₁-C₆ alkyl is “substituted with halo, hydroxyl, -OC₁-C₆ alkyl, cyano, SO₂(C₁-C₆ alkyl), OCF₃, CF₃, CONH₂, CON(CH₃)₂, or NO₂”. (Emphasis added.) The other variables, R1-R4, and R6-R11, are not further limited from their initial definitions in the claim.

In Dodge R5 is “hydrogen, C₁ C₆ alkyl, aryl, and C₁-C₆alkylaryl”. The C₁-C₆alkylaryl is not substituted as in the instant claims nor is R5 hydroxy, or C₁-C₆alkoxy.

3. In the third proviso, R6 and R7 are independently “unsubstituted or substituted C₁-C₆alkyl or unsubstituted or substituted C₂-C₆alkenyl *with the proviso that at least one group is substituted*”. (Emphasis added.) The other variables, R1-R5 and R8-R11, are not further limited from their initial definitions in the claim.

In Dodge, R6 and R7 are independently “hydrogen, C₁ C₆alkyl, C₂-C₆alkenyl”. Neither of R6 or R7 is a substituted alkyl or alkenyl group.

4. In the fourth proviso, R6 is hydrogen and R7 is *substituted C₁-C₆alkyl* or *substituted C₂-C₆alkenyl*. The other variables, R1-R5 and R8-R11, are not further limited from their initial definitions in the claim.

In Dodge, as noted above, R6 and R7 are independently “hydrogen, C₁ C₆alkyl, C₂-C₆alkenyl” The variable R7 is not a substituted alkyl or substituted alkenyl.

5. In the fifth proviso, R6 and R7 together with the carbon atom to which they are attached form a *substituted C₃-C₈ cycloalkyl* group which is optionally partly unsaturated.” (Emphasis added.) The other variables, R1-R5 and R8-R11, are not further limited from their initial definitions in the claim.

In Dodge, R6 and R7 “together with the carbon atom to which they are attached may form a carbocyclic ring.” The carbocyclic ring is not substituted.

6. In the sixth proviso, R8 is *substituted* C₁-C₆alkyl, *substituted* aryl, unsubstituted or substituted (C₁-C₆alkyl)C₃-C₈cycloalkyl or *substituted* C₁-C₆alkylaryl. (Emphasis added.) The other variables, R1-R7 and R9-R11, are not further limited from their initial definitions in the claim.

In Dodge, R8 is selected from: hydrogen, C₁ C₆alkyl, aryl, and C₁ C₆alkylaryl. Neither of the alkyl moieties nor the aryl group is substituted.

The provisos listed above are written in the alternative so that at least one must be considered when construing the claim scope. Each, considered individually, distinguish the presently claimed invention from that of Dodge. Therefore, the present claim 1 considered in its entirety is not non-obvious over the claims of Dodge. In light of the above comments, it is respectfully maintained that one skilled in the art would not be motivated to modify the compounds in of Dodge, including the genus encompassed by the claims to arrive at the instantly claimed compounds. Withdrawal of this provisional rejection is requested.

II. Rejections Under 35 USC § 112

Claim 43 is rejected as indefinite for reciting the phrase “A method c thereof”. Claim 43 has been amended to delete reference to “c thereof” and, therefore, correct the typographical error in the last submission. Withdrawal of this rejection is requested.

III. Rejections Under 35 USC § 102

Claims 1, 5, 22-32, 27, 38 and 63-68 were rejected under 35 U.S.C. 102(e) as being anticipated by Dodge. Example 13 in Dodge was specifically referred to as anticipating the claimed invention. As noted above claim 1 has been amended specifically the variables for R5 now recite that the specific substituents on the substituted alkyl group i.e., -OC₁-C₆ alkyl, cyano, SO₂(C₁-C₆ alkyl), OCF₃, CF₃, CONH₂, CON(CH₃)₂, or NO₂. In light of this amendment claim 1 is now not anticipated by Dodge (including example 13). In Example 13 for the R5 alkyl group is substituted with an aryl group. This is excluded from the presently claimed invention. The remaining rejected claims depend either directly or indirectly from claim 1. In light of this amendment, withdrawal of the rejection is requested.

IV. Claim Amendments

Claims 29, 50, 56, 62, 68, and 74 have been amended to correct minor typographical

errors, by deleting the word “of” in the preamble in each claim.

V. Conclusion

Applicants respectfully request timely examination of this application leading to allowance of all elected claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Respectfully submitted,

/James B. Myers/
James B. Myers
Attorney for Applicants
Registration No. 42,021
Phone: 317-276-0755

Eli Lilly and Company
Patent Division/
P.O. Box 6288
Indianapolis, Indiana 46206-6288

17 September 2008